

THIS OPINION WAS NOT WRITTEN FOR PUBLICATION

The opinion in support of the decision entered today (1) was not written for publication in a law journal and (2) is not binding precedent of the Board.

Paper No. 19

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte SHOLOM S. ROSEN

Appeal No. 2003-0993
Application 09/314,738¹

MAILED

JUL 7 - 2003

PAT. & T.M. OFFICE
BOARD OF PATENT APPEALS
AND INTERFERENCES

ON BRIEF

Before LEE, SCHAFER and MEDLEY, Administrative Patent Judges.

LEE, Administrative Patent Judge.

DECISION ON APPEAL

This is a decision on appeal under 35 U.S.C. § 134 from the examiner's rejection of appellant's claims 1-11. No claim has been allowed.

The Rejection on Appeal

Claims 1-11 stand rejected under 35 U.S.C. § 112, first paragraph, as being without written description in the specification.

¹ Application for patent filed May 19, 1999. According to the appellant, it is a division of 08/895,395, filed July 16, 1997, now Patent 6,175,921, which is a division of 08/730,158, filed October 23, 1996, now Patent 5,703,949, which is a continuation of 08/575,699, filed December 19, 1995, which is a division of 08/234,461, filed April 28, 1994, now Patent 5,557,518. The real party in interest is Citibank N.A.

The Invention

Independent claims 1, 6 and 11 are reproduced below:

1. An electronic ticket vending system comprising:

an electronic ticket vending device that generates an electronic ticket and executes at least one of vending and refunding by exchanging the generated electronic ticket with electronic money;

a communication line connected to said vending device;

at least one host processor connected to said communication line that executes input, output, transmission and reception for executing at least one of vending and refunding of an electronic ticket; and

an electronic ticket storage device, having an interface that electronically connects to said host processor, where said electronic ticket storage device stores electronic money, an electronic ticket, and a transaction history including transactions of electronic money and electronic tickets, and where said transaction history is updated, by a program stored in said electronic ticket storage device, after a transfer of either electronic money or an electronic ticket;

where in response to an electronic ticket purchase request or an electronic ticket refund request, by at least said host processor or said electronic ticket storage device, at least said electronic ticket or said electronic money is sent from said electronic ticket vending device via said communication line.

6. An electronic ticket vending method in a system comprising an electronic ticket vending device, at least one host processor, and a communication line connecting said electronic ticket vending system and said at least one host processor, said method comprising:

a step of sending a request to purchase an electronic ticket to said electronic ticket vending device from at least one of said host processors connected to an electronic ticket storage device having an interface that electronically connects to said host processor, where said electronic ticket storage device stores electronic money, an electronic ticket, and a transaction history including transactions of electronic money and electronic tickets, and where said

transaction history is updated by a program stored in said electronic ticket storage device after a transfer of either electronic money or an electronic ticket;

a step of sending a request for ticket payment to said electronic ticket storage device, when said electronic ticket can be vended from said electronic ticket vending device;

a step of sending electronic money, in an amount consistent with said request, to said electronic ticket vending device from said electronic ticket storage device via said communication line;

a step of sending said electronic ticket to said electronic ticket storage device from said electronic ticket vending device after said electronic money is received; and

a step of receiving said sent electronic ticket via said host processor and storing it in said electronic ticket storage device connected to said host processor.

11. An electronic ticket vending system comprising:

an electronic ticket vending device having a processor programmed to generate an electronic ticket and execute at least one of vending and refunding by exchanging the generated electronic ticket with electronic money;

a communication line connected to said vending device;

at least one host processor connected to said communication line programmed to execute input, output, transmission and reception for executing at least one of vending and refunding of an electronic ticket; and

an electronic ticket storage device having an interface that electronically connects to said host processor, where said electronic ticket storage device has a processor programmed to store electronic money, an electronic ticket, and a transaction history including transactions of electronic money and electronic tickets, and where said processor is programmed to update said transaction history after a transfer of either electronic money or an electronic ticket;

where in response to receiving an electronic ticket purchase request or an electronic ticket refund request, said electronic ticket vending device is

programmed to send at least said electronic ticket or said electronic money to said electronic ticket storage device via said communication line.

The appellant has grouped claims 1-11 together for this appeal. (Br. at 5)

Discussion

The sole rejection is under 35 U.S.C. § 112, first paragraph, for lack of written description in the specification as filed, for the claimed invention. Each of the rejected claims 1-11, however, is in its original form precisely as it was, unamended, in the appellant's application as filed on May 19, 1999. It is well established under controlling precedent of the Court of Customs and Patent Appeals, that original claims in their unamended form are a part of the original specification as filed. E.g., In re Koller, 613 F.2d 819, 823, 204 USPQ 702, 706 (CCPA 1980); In re Gardner, 475 F.2d 1389, 1391, 177 USPQ 396, 397 (CCPA 1973). If the examiner is relying on the specification of an ancestral application to the appellant's involved application for making the rejection under 35 U.S.C. § 112, first paragraph, that is improper. See Reiffin v. Microsoft, 214 F.3d 1342, 1346, 54 USPQ2d 1915, 1918 (Fed. Cir., 2000).

The examiner has not explained and set forth why original claims 1-11 do not provide adequate written description for claims 1-11 on appeal, which are identical to original claims 1-11. Accordingly, a prima facie case for lack of written description under 35 U.S.C. § 112, first paragraph, has not been made. We cannot sustain the rejection of claims 1-11.

Appeal No. 2003-0993
Application 09/314,738

Conclusion

The rejection of claims 1-11 as failing to satisfy the written description requirement of 35 U.S.C. § 112, first paragraph, is reversed.

REVERSED

Jameson Lee
JAMESON LEE)
Administrative Patent Judge)
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Richard E. Schafner
RICHARD E. SCHAFER) BOARD OF PATENT
Administrative Patent Judge) APPEALS AND
) INTERFERENCES
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Sally C. Medley
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